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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,689	10/13/2000	William J. Bussick	0112300/474	7705

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EXAMINER

JONES, SCOTT E

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 02/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/687,689	BUSSICK ET AL.	
	Examiner	Art Unit	
	Scott E. Jones	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,9,10,12,13,15,17,20,22,25-28,31,32,34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32 and 35 is/are allowed.
- 6) ☒ Claim(s) 1,4,7,9,10,12,13,15,17,20,22,31 and 34 is/are rejected.
- 7) ☒ Claim(s) 3 and 25-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. This office action is in response to the request for continued examination and amendment filed on November 17, 2004 in which applicant amends claims 1, 31, and 34 and responds to the claim rejections. Claims 1, 3-4, 7, 9-10, 12-13, 15, 17, 20, 22, 25-28, 31-32, and 34-35 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 17, 2004 has been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 4 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claim 4, the specification is enabling to "employing a video monitor, wherein the symbols are simulated and changing the symbols includes replacing one simulated symbol with another preferably through

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an entertaining and exciting method. Alternatively, the present invention can employ a mechanical symbol display having a mechanism to change the symbols or a method to indicate that a symbol has changed” (Page 5, lines 3-8). However, the specification does not disclose replacing the selected symbols without spinning the reels as claimed in claim 4. In fact, claim 4 as originally filed states, “The method of Claim 1, wherein generating a set of symbols includes a second spinning of the symbols on a reel used for the replacement of said symbols.” Claim 31 recites, “evaluating said first set to determine if any award yielding symbol combinations are displayed and providing a player an award for each award yielding combination....selecting a plurality but not all of the symbols in said first set for individual replacement whether or not any award yielding symbol combinations are displayed in the first set...”. However, upon a closer reading of the specification, the step of replacing symbols in a first set only occurs after a winning combination is obtained in the first set of symbols. Furthermore support for the examiner’s position can be found in the instant specification at page 4, lines 15-18, which states, “Specifically, the present invention provides a new method of evaluating winning combinations of symbols when one or more of the symbols changes and a winning combination exists before the change and a new winning combination exists after the change.”

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 1, 7, 9-10, 12-13, 15, 17, 20, 22, 31, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Halloran (U.S. 6,439,993).

O'Halloran discloses a method and apparatus for operating a gaming machine having a plurality of simulated spinning reels capable of displaying a wild card symbol at any of the reels. Upon the appearance of a first wild card symbol, additional wild card symbols may appear, providing the player with additional opportunities to win a prize, or to win an additional prize.

O'Halloran discloses:

Regarding Claim 1:

- maintaining a list of award-yielding symbol combinations of said plurality of symbols in a controller (column 2, lines 36-40 and 48-51);
- randomly generating on a plurality of paylines associated with said reels a first set of the symbols from the plurality of symbols, said first set including a plurality of symbols generated on each of a plurality of the reels (abstract, figs. 1-5, column 2, lines 44-54, column 3, lines 18-30, and claim 3);
- providing a player an award for each award-yielding symbol combination appearing in said first set on any of the paylines before any said symbol can be replaced (column 3, lines 18-30 and claim 3);
- selecting a plurality but not all of the symbols in the first set for individual replacement, said symbols being all of the plurality of symbols generated on one of the reels and individually replacing each said selected symbol in the first set with one of the plurality of symbols to generate a second set of the symbols, the second set of

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symbols displayed in place of the first set of symbols (column 3, lines 18-30 and claim 3); and

- providing the player an award for each award-yielding symbol combination appearing in said second set on any of the playlines even if any said award yielding symbol combination in the second set appeared in the first set and even if an award is provided for said symbol combination in the third bulleted paragraph recited above (column 3, lines 18-30 and claim 3).

Regarding Claim 7:

- the first set of symbols and second set of symbols is part of a bonus game (column 2, line 60-column 3, line 9). The appearance of a first wild symbol in a combination is a trigger for and is inclusive to the bonus game which comprises replacing other non-wild card symbols with other wild card symbols for an additional prize amount.

Regarding Claims 9 and 15:

- the step of replacing each selected symbol in the first set includes substituting a wild symbol for each selected symbol (non-wild card symbol) in the first set, and wherein each wild symbol functions as one of the plurality of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, and claim 3).

Regarding Claim 10:

- the step of replacing each selected symbol in the first set includes substituting a wild symbol for each selected symbol (non-wild card symbol) in the first set, and wherein each wild symbol sequentially functions as at least one of the plurality of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, and claim 3).

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Regarding Claim 12:

- the step of replacing each selected symbol includes individually replacing one of the other symbols on a plurality of reels, wherein said symbol functions as one of the plurality of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, and claim 3).

Regarding Claim 13:

- the step of replacing each selected symbol in the first set includes substituting a wild symbol for at least one symbol on another one of said reels, wherein each said wild symbol functions as one of the plurality of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, and claim 3).

Regarding Claims 17, 20, and 22:

- maintaining in a controller of said gaming device a list of award-yielding symbol combinations of said plurality of symbols (column 2, lines 36-40 and 48-51);
- generating a first set of said symbols on the reels, wherein one of said symbols in said first set is a first wild symbol, said first set including a plurality of generated symbols on each of a plurality of the reels (abstract, figs. 1-5, column 2, lines 44-54, column 3, lines 18-30, and claim 3);
- providing a player an award for each award-yielding symbol combination appearing in said first set including any award symbol combinations that include the first wild symbol, the first wild symbol functioning as one of the other symbols to maximize the award yielding combinations (column 3, lines 18-30 and claim 3);

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- selecting a plurality but not all of the symbols in the first set except for the first wild symbol in the set for individual replacement, said symbols being all of the plurality of symbols generated on one of the reels and individually replacing each said selected symbol with a second wild symbol to create a second set of symbols that is displayed in place of the first set of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, column 3, lines 18-30 and claim 3); and
- providing the player an award for each award-yielding symbol combination appearing in said second set including any award yielding symbol combinations created with the first wild symbol and any award yielding symbol combinations created with the first and second wild symbols, wherein each of the first and the second wild symbols function as one of the symbols to maximize the award yielding symbol combinations, wherein the award for each award yielding symbol combination in the second set is in addition to the award for each award yielding symbol combination in the first set (column 1, lines 31-44 and 48-54, column 2, lines 54-59, column 3, lines 18-30 and claim 3).

Regarding Claims 31 and 34:

- randomly generating on a plurality of paylines associated with the reels a first set of said symbols, said first set including a plurality of symbols on each of a plurality of reels (abstract, figs. 1-5, column 2, lines 44-54, column 3, lines 18-30, and claim 3);
- providing a player an award for each award-yielding symbol combination appearing in said first set on any of the paylines (column 3, lines 18-30 and claim 3);

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- selecting a plurality but not all of the symbols in the first set for individual replacement, said symbols being at least two predetermined symbols on the reels and individually replacing each said selected symbol with one of the symbols to create a second set of symbols that is displayed in place of the first set of symbols (column 3, lines 18-30 and claim 3); and
- providing the player an award for each award-yielding symbol combination appearing in said second set on any of the playlines including all award yielding symbol combinations in the second set even if an award was provided for such award yielding combinations in the first set and even if an award is provided for said symbol combination in the second bulleted paragraph recited above (column 3, lines 18-30 and claim 3).

Allowable Subject Matter

7. Claims 32 and 35 are allowed because O'Halloran cannot be used in a 35 U.S.C. 103 rejection as a result of O'Halloran and the instant invention being commonly assigned at the time of Applicant's invention.

8. Claims 3 and 25-28 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed November 17, 2004 have been fully considered but they are not persuasive with regards to the rejection to Claims 1, 4, 7, 9-10, 12-13, 15, 17, 20, 22, 31, and 34 under 35 U.S.C. 102(e) as being anticipated by O'Halloran (U.S. 6,439,993).

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10. Applicant respectfully disagrees and traverses the rejection to Claims 1, 7, 9-10, 12-13, 15, 17, 20, 22, 31, and 34 under 35 U.S.C. 102(e) as being anticipated by O'Halloran (U.S. 6,439,993).

Regarding claims 1, 17, 31, and 34, Applicant alleges O'Halloran does not expressly or inherently disclose replacing each selected symbol from a first set of symbols on a plurality of paylines. Specifically, Applicant alleges O'Halloran does not disclose replacing the selected symbols which are all on one of the reels (rather than on one of the paylines on multiple reels). The examiner respectfully disagrees. Although O'Halloran's description is limited to one winning line, more than one winning line can be defined and selected by the player (Column 2, lines 50-54). Therefore, it is possible to have symbols on each of the win lines being changed to wild or functional symbols, wherein the changed symbols could all be on the same reel but different win lines. For instance, in Figure 4a, the trigger (@) is obtained on reel 2 (top row). Given more than one winning line can be defined and selected by the player (Column 2, lines 50-54), when the @ symbol is obtained on reel 2 (middle row) and reel 2 (bottom row), then each of the symbols on reels 3, 4, and 5 are replaced. Therefore, the examiner maintains O'Halloran anticipates the claims.

Regarding claim 7, Applicant alleges O'Halloran does not disclose a bonus game. However, the examiner respectfully disagrees. O'Halloran's "providing a player with an additional opportunity to win a prize or to win an additional prize" equates to a bonus game. Merriam-Webster's Collegiate Dictionary, Tenth Edition defines bonus as something in addition to what is expected or strictly due.

Regarding claims 9, 10, 12, 15, 17, 20, and 22, Applicant similarly alleges O'Halloran does not disclose replacing each selected symbol in the first set with a wild symbol which functions as one of the plurality of symbols. The examiner respectfully disagrees. Please see column 1, lines 31-44 and 48-54, column 2, lines 54-59, and claim 3 as indicated in the rejection above.

Regarding claim 31, please see the rejection above under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

For the reasons discussed hereinabove, the examiner maintains O'Halloran anticipates the claims.

11. Applicant's arguments, see pages 19-20, filed November 17, 2004, with respect to the rejection to claims 25-28, 32, and 35 under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (U.S. 6,439,993) and the rejection to claim 3 under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (U.S. 6,439,993) in view of Jaffe (U.S. 6,551,187) have been fully considered and are persuasive because O'Halloran cannot be used in a 35 U.S.C. 103 rejection as a result of O'Halloran and the instant invention being commonly assigned at the time of Applicant's invention. The rejection to claims 25-28, 32, and 35 under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (U.S. 6,439,993) and the rejection to claim 3 under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (U.S. 6,439,993) in view of Jaffe (U.S. 6,551,187) of have been withdrawn.

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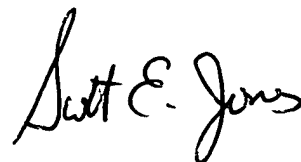
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (571) 272-4438. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones
Examiner
Art Unit 3713



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